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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,882	09/06/2006	Uwe Skultety-Betz	10191/4519	6955
26646 7590 05/07/2009 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
WHITTINGTON, KENNETH				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/591,882

Applicant(s)

SKULTETY-BETZ, UWE

Examiner

KENNETH J. WHITTINGTON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2009.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 14-25 and 27 is/are rejected.
7) ☒ Claim(s) 26 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 06 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 23, 2009 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-16, 18-20, 23, 24 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Garrett (US3662255). Regarding claim 14, Garrett discloses a hand-held locating device for detecting an object enclosed in a medium, comprising:

a housing having an opening penetrating there through configured in size to guide a device for marking a surface of the medium (See Garrett FIGS. 1 and 9, item 32 or 32a or 50a, note that openings in the housing can accommodate a marker or pencil or other writing device therein or therethrough. Note also that

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the inner ring surface of the openings can be used to guide the marking device to draw a circle in the desired medium below the housing);

at least one sensor system positioned in the housing (See FIGS. 1 and 9, item 45 or 45a); and

at least one light source provided in the measuring device configured to illuminate the opening (See FIG. 9, items 200), and

a handle attached to the housing, the handle situated in close proximity to the housing so as to permit an operator to grasp the handle while operating the device for marking a surface of the medium (See FIG. 1, item 30 and see col. 7, lines 18-21);

wherein the medium is situated outside of the locating device (See col. 7, lines 22-25, note the ground or a wall can be the medium which is located outside the device).

Regarding claim 15, Garrett discloses the sensor system has at least one inductive sensor for locating purposes (See FIGS. 1-9, item 45 or 45a).

Regarding claim 16, Garrett discloses the inductive sensor includes a coil, the opening being oriented concentrically in relation to the coil of the inductive sensor (See FIGS. 1-9, note coil 45 or 45a in relation to housing with opening 32 or 32a).

Regarding claim 18, Garrett discloses the opening is formed by a sleeve, the light source configured to illuminate the sleeve (See FIG. 9, note item 50a).

Regarding claim 19, Garrett discloses the sleeve is made of an at least partially transparent plastic (See FIGS. 1-9, item 50 or 50a and see col. 3, lines 31-38).

Regarding claim 20, Garrett discloses the sleeve is configured to scatter light diffusively (See FIGS. 1-9, item 50a, note material is translucent).

Regarding claim 23, Garrett discloses the opening is variably illuminated as a function of a measuring signal of at least one sensor (See col. 7, lines 11-17).

Regarding claim 24, Garrett discloses the light source includes a plurality of light sources (See FIG. 9, note plurality of bulbs 200).

Regarding claim 27, Garrett discloses a hand-held locating device for detecting an object enclosed in a medium, comprising:

a housing having an opening penetrating therethrough, the opening configured in size to guide a device for marking a surface of the medium (See Garrett FIGS. 1 and 9, item 32 or 32a or 50a, note that openings in the housing can accommodate a marker or pencil or other writing device therein or therethrough. Note also that the inner ring surface of the openings can be used to guide the marking device to draw a circle in the desired medium below the housing);

at least one sensor system positioned in the housing, the sensor system having at least one inductive sensor for locating purposes, the sensor being situated concentrically in relation to the opening (See FIGS. 1-9, note coil 45 or 45a in relation to housing with opening 32 or 32a);

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at least one light source provided in the measuring device configured to illuminate the opening (See FIG. 9, items 200); and

a handle attached to the housing, the handle situated in close proximity to the housing so as to permit an operator to grasp the handle while operating the device for marking a surface of the medium (See FIG. 1, item 30 and see col. 7, lines 18-21);

wherein the medium is situated outside of the locating device (See col. 7, lines 22-25, note the ground or a wall can be the medium which is located outside the device).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett in view of Yamashita et al. (US4859931), hereinafter Yamashita. Regarding this claim, Garrett teaches the use of an inductive sensor arrangement, but not including a capacitive sensor. Yamashita teaches using both an inductive sensor and a capacitive sensor in the same device (See Yamashita col. 1, lines 33-65). It would have been obvious at the time the invention was made to incorporate a capacitive sensor into the metal detector of

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Garrett. One having ordinary skill in the art would do so to locate both metal and non-metallic objects (See Yamashita col. 1, lines 9-13).

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett in view of Audet (US6266006). Regarding these claims, Garrett teaches of the features of claim 14 as discussed above, but not a color coded light signal. Audet teaches an inductive metal/object detector having a light source that is illuminated with a color-coded light signal in at least two different colors (See Audet col. 3, lines 23-35). It would have been obvious at the time the invention was made to incorporate the color coded signal of the detector in Audet in the metal detector of Garrett. One having ordinary skill in the art would do so to provide a definite indication of the presence of an object (See Audet col. 3, lines 23-35).

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett in view of Steber et al. (US6844713), hereinafter Steber. Regarding this claim, Garrett teaches the use of neon lamps for the light source, but not an LED. Steber teaches a stud finder using LEDs as light sources behind a translucent material (See Steber FIG. 12, note LEDs D2-D5 behind translucent windows 113). It would have been obvious at the time the invention was made to incorporate LEDs in lieu of the neon lamps in the apparatus of Garrett. One having ordinary skill in the art would do so because either can be used to provide a light signal through translucent material as shown in these references.

Allowable Subject Matter

Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: regarding this claim, the prior art does not show or teach the hand held device with a sealing device having the features as recited in this claim and in combination with the other features of this claim.

Response to Arguments

In view of the substantial amendments to claim 1, the rejections applying Engelberg et al. (US2006/0062472) are withdrawn.

Regarding the remaining rejections applying Garrett, the arguments are not persuasive and the rejections as amended above in view of the claim amendments are maintained.

Applicant's first argument regarding the Garrett rejections is that the metal detector of Garrett is not "configured in size to guide a marking device". Applicant further notes the space in Garrett is relatively large. However, such large size and circular shape would provide an excellent guide for marking the medium below. The user of the Garrett metal detector would simply place the metal detector on the surface of the medium (which could be the ground or a wall as noted in Garrett col. 7, lines 22-25), then take the marking device and drag it along the inner surface of the detector rings of Garrett (See inner surface of

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items 32 or 33) and at the same time drag the marker over the medium below the metal detector rings. Thus, the user could mark general circles into the medium to identify the location of a metal object in the medium using the inner surface of the rings as a guide. Accordingly, Garrett discloses this feature.

Applicant then argues that the outer assembly of the metal detector of Garrett is located at "a relatively great distance from the hand-held portion of the device". However, such argument ignores the explicit disclosure of Garrett at col. 7, lines 18-21, which states the handle between the handle and the indicator assembly need not be long, but on a small dimension housing held directly by the operator. Furthermore, even with a long handle, it would not be beyond the physical limitation of a user of the metal detector of Garrett to use a long marker (such as even a stick) to mark the ground surface inside the detector rings as noted in the previous paragraph.

Similar arguments are made for new independent claim 27.

Regarding the remaining dependent claims, Applicant has made no arguments beyond those for the independent claim 14 and thus no response is necessary beyond addressing those arguments pertaining to claim 14.

Newly Cited Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US6211662, US5325873, US5434500 each teach varying designs of marking openings for metal detectors to accommodate or guide a marking device to mark a surface of a medium.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENNETH J. WHITTINGTON whose telephone number is (571)272-2264. The examiner can normally be reached on Monday-Friday, 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Assouad can be reached on (571) 272-2210. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth J Whittington/
Primary Examiner, Art Unit 2862

kjw